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7590 Ralph D. Gelling Perman & Green, LLP 425 Post Road Fairfield, CT 06430			EXAMINER GELIN, JEAN ALLAND	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AHTI MUHONEN

Appeal 2009-2202
Application 09/836,792
Technology Center 2600

Decided:¹ June 15, 2009

Before MAHSHID D. SAADAT, MARC S. HOFF,
and ELENI MANTIS MERCADER, *Administrative Patent Judges*.

SAADAT, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Appellant appeals under 35 U.S.C. § 134(a) from a Final Rejection of claims 1-10. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

STATEMENT OF THE CASE

Appellant's invention relates to a mobile station having an adaptive mode that allows certain of its functions be programmed for operation in a variety of modes and systems (Spec. 2). According to Appellant, such configuration leads to universal global operation for cellular telephones (*id.*).

Independent claim 1 is illustrative of the invention:

1. A mobile station, configured for use as a software radio having the capability for universal adaptive use within independent, globally dispersed cellular communication networks, comprising:

a transceiver for receiving data over a common system parameter channel from a local one of said independent, globally dispersed networks into which the mobile stations has traveled, wherein said data is received directly without reliance on any local area network or wireline system;

a first processor for compiling and storing network characteristic data relating to said local one of said independent, globally dispersed cellular communication networks, received over said common system parameter channel, relating to operational capabilities of said cellular networks;

a second processor for compiling and storing subscriber identification data relating to operational capabilities of said mobile station;

a third processor for combining said network characteristic data and said subscriber identification data into an addressable matrix of operational capabilities; wherein said third processor further generates

an operational configuration based on said matrix and predetermined criteria.

The Examiner relies on the following prior art references in rejecting the claims:

van den Heuvel	GB 2 294 844 A	May 8, 1996
Henry	US 5,603,084	Feb. 11, 1997
Bridges	US 6,546,246 B1	Apr. 8, 2003 (effectively filed Mar. 6, 1998)
Sainton	US RE38,787 E	Aug. 30, 2005 (filed Sep. 8, 1999)

Claims 1, 2, and 5-10 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over van den Heuvel in view of Bridges and Sainton.

Claims 3 and 4 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over van den Heuvel, Bridges, and Sainton in view of Henry.²

Rather than repeat the arguments here, we make reference to the Brief and the Answer³ for the respective positions of Appellant and the Examiner.

ISSUE

The issue is whether Appellant has shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103 (a). Specifically, Appellant and the Examiner disagree as to whether van den Heuvel, Bridges, and Sainton disclose a transceiver that receives data over a common system parameter channel globally dispersed networks without reliance on any local area network or wireline system, as recited in claim 1 (Br. 9-12). Further,

² The final rejection of the claims is repeated in pages 3-13 of the Examiner's answer.

³ We refer to the Appeal Brief filed Oct. 17, 2007 and the Examiner's Answer mailed Jan. 25, 2008.

Appellant challenges the combination of the references as to whether it would have been obvious to one of ordinary skill in the art to modify van den Heuvel with the teachings of Bridges and Sainton (Br. 11). Therefore, the issue turns on whether there is a legally sufficient justification for combining the disclosures of van den Heuvel, Bridges, and Sainton and if so, whether the combination of the applied references teaches the claimed subject matter.

FINDINGS OF FACT

The following findings of fact (FF) are relevant to the issue involved in the appeal.

Van den Heuvel

1. van den Heuvel relates to availability of other communication systems within the common communication system coverage area to a generic subscriber unit. (Abstract.)

2. As shown in Figure 1, in response a subscriber access request, van den Heuvel's common communication system 19 provides a list of systems available for use in network 10 along with information on their features and costs (van den Heuvel, 3:28-34).

3. van den Heuvel further describes the subscriber unit access to the common communication unit as passive since the subscriber unit may only monitor the information being transmitted by the common communication system (van den Heuvel, 4:8-13).

Bridges

4. The roaming system disclosed in Bridges selects a preferred wireless carrier from a list of preferred wireless carrier identities that is

stored based on a national account assigned to a mobile station for a plurality of market areas. (Abstract.)

5. Bridges provides for an intelligent roaming capability that provides seamless integration without modifying the standards used by each cellular service provider. (Col. 4, ll. 39-59.)

Sainton

6. Sainton relates to operating a network wireless service provider for interacting with different wireless products within a given geographic area by allowing the providers to use radio frequencies from other providers within the same geographic region. (Abstract.)

7. The system disclosed by Sainton utilizes any one of the wireless data services within a given geographic area according to manual selection by the user or a preprogrammed routine for selecting information based on varying criteria, such as cost, quality, availability, and security of transmission. (Col. 16, ll. 32-58.)

PRINCIPLES OF LAW

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) (stating that 35 U.S.C. § 103 leads to three basic factual inquiries: the scope and content of the prior art, the differences between the prior art and the claims at issue, and the level of ordinary skill in the art). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie*

case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992).

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. *See In re Kahn*, 441 F.3d 977, 987-88 (Fed. Cir. 2006); *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007).

Such a showing requires

‘some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.

Id. at 418 (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Further, a rejection based on § 103 must rest upon a factual basis rather than conjecture or speculation. “Where the legal conclusion [of obviousness] is not supported by facts it cannot stand.” *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). *See also In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006).

ANALYSIS

Rejection over van den Heuvel, Bridges, and Sainton

With respect to the rejection of claims 1, 2, and 5-10, Appellant argues that neither of the cited references encourages a person skilled in the

art to pick the components of each reference to construct the claimed system (Br. 9). Appellant particularly asserts that the diversity of the references may be understood, for example, by van den Heuvel's requirement for an initial contact to receive information on available networks and their features (*id.*), which relates to a local instead of a global system (Br. 10). Appellant further argues that using a list of preferred service providers in Bridges and borrowing of radio frequencies among wireless service providers of a network within the same geographical region in Sainton also refer to a local, instead of a global, system (Br. 11-12).

The Examiner relies on Sainton for teaching data reception by a mobile device that travels within independent globally dispersed networks (Ans. 13). The Examiner characterizes the claimed channel from a local one of independent globally dispersed networks as the capability of operating over a plurality of different radio channels disclosed by Sainton (Ans. 13-14). Regarding the combinability of the references, the Examiner refers to the same field of endeavor being shared by the references (Ans. 14). The Examiner also points out that Bridges suggests obtaining the provider "with which the home cellular service provider has the best roaming agreement" while Sainton allows for adaptive selection of service providers based on the user's experience with specific providers (Ans. 15).

We disagree with the Examiner's conclusion that the capability of operating over different radio channels in Sainton is the same as operating over globally dispersed networks without relying on any local area network. In that regard, we find the Examiner's reasoning to be based on speculation, rather than supported by evidence. While Sainton interacts with different wireless products (FF 6), those services are within a given geographical area

(FF 6-7). We agree with the Examiner's findings to the extent that Sainton allows different radio frequencies to be used for accessing the offered services (FF 6-7). However, as argued by Appellant (Br. 11-12), the portions of Sainton relied on by the Examiner do not define the operating area of the different frequencies as anything other than a local area. In other words, the services are still provided by the local area network systems.

We also find that the Examiner's discussion of the reasons to combine the references (Ans. 14-15) falls short of the required articulated reasoning. In that regard, the Examiner has not shown that, based on the teachings or suggestions found in van den Heuvel, Bridges, or Sainton, the combination of the references would have resulted in receiving data over a channel in a globally dispersed system without relying on a local network. Although Sainton provides for different frequencies, they are all within the same local area (FF 6-7). Similarly, van den Heuvel provides a list of available systems within a coverage area (FF 1-2) which may be accessed by the subscriber in a passive way (FF 3). Bridges, on the other hand, uses roaming agreements which rely on using local carriers for a seamless access (FF 4-5).

As noted by Appellant, picking the elements of local networks discussed by the Examiner from each of the references does not result in the claimed subject matter. Furthermore, the combination also lacks the requisite analysis outlined in *KSR* to show predictable results or any solution that a person of ordinary skill in the art would have pursued or even tried. Thus, since the combination of the references does not teach or suggest all the claimed requirements, and the Examiner's conclusion that it would have been obvious to the skilled artisan to combine the references is not supported by 'some articulated reasoning with some rational underpinning to support

the legal conclusion of obviousness' based on the teachings or suggestions of van den Heuvel, Bridges, or Sainton, the 35 U.S.C. § 103(a) of claims 1, 2, and 5-10 over van den Heuvel, Bridges, and Sainton cannot be sustained.

Rejection over van den Heuvel, Bridges, Sainton, and Henry

With respect to the rejection of claims 3 and 4, we observe that the Examiner has not identified any teachings in Henry to overcome the deficiencies related to the features of base claim 1, in the combination of van den Heuvel, Bridges, and Sainton discussed above. Therefore, we do not sustain the 35 U.S.C. § 103 rejection of claims 3 and 4 over van den Heuvel, Bridges, Sainton, and Henry.

CONCLUSION

On the record before us, we find that the Examiner fails to make a prima facie case that the combination of van den Heuvel, Bridges, and Sainton would have taught or suggested a transceiver that receives data over a common system parameter channel globally dispersed networks without reliance on any local area network or wireline system, as recited in claims 1 and 8. Therefore, in view of our analysis above, the 35 U.S.C. § 103 (a) rejection of claims 1-10 cannot be sustained.

DECISION

The decision of the Examiner rejecting claims 1-10 is reversed.

REVERSED

Appeal 2009-2202
Application 09/836,792

gvw

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